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Yuan-Chang Chin

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EXAMINER

PHANTANA ANGKOOL, DAVID

ART UNIT

PAPER NUMBER

2175

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/729,979	Applicant(s) CHIN, YUAN-CHANG	
	Examiner David Phantana-angkool	Art Unit 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2175

DETAILED ACTION

1. This application has been reassigned to Examiner David Phantana-angkool.
2. This action is responsive to the following communications: Amendment filed on July 21st, 2008. **This action is made final.**
3. Claims 15-24 are pending claims.

Claim Rejections - 35 USC § 102

4. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 15, 17, 21 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Jung et al. (20040081434).**

As for independent claim 15:

Re claim 15, Jung et al. discloses a disc editing method for a digital recording/playing device: building a font recording space in a recordable optical disc that stores multi-media data; pre-recording at least one font file in the font recording space, the font file comprising a plurality of font codes(character data and figure 7 for example); inputting an inside code (synchronization information for example) to specify a font code in the font file; editing a name of the multi-media data with the inside code and the font file (see paragraph 0034 and 0037 for example); recording the inside code in the recordable optical disc (see paragraph 0075 for example); searching the font file for the font code mapping to the inside code (see paragraph 0049 and 0050 for example) ; reading the searched font code; and updating an on screen display (OSD) based on the font code (see claim 16 for example).

As for dependent claim 17:,

Jung et al. discloses a disc editing method, wherein the font file is stored in a storage medium (see

Art Unit: 2175

paragraph 0048 for example).

As for dependent claim 21: Jung et al. discloses a disc editing method, wherein the font file has a plurality of font data sets stored therein, and the font data set is composed of the inside code and the font code (see paragraph 0037 and figure 7 for example).

As for dependent claim 24: Jung et al. discloses a disc editing method, wherein the inside code is inputted via a user interface (see claim 21 for example).

Claim Rejections - 35 USC § 103

6. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 16, 18-20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung et al. (20040081434).**

As for dependent claim 16:

Re claim 16, the system of Jung et al. discloses the claimed invention except wherein the font recording space is a file wrapper index. It would have been an obvious matter of design choice to have it programmed to use wherein the font recording space is a file wrapper index, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious

Art Unit: 2175

under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

As for dependent claim 18:

Accordingly,

Re claim 18, the system of Jung et al. discloses the claimed invention except wherein the storage medium is a hard disc installed in the digital recording/playing device. It would have been an obvious matter of design choice to have it programmed to use wherein the storage medium is a hard disc installed in the digital recording/playing device, since such a modification would have involved the mere application of a known technique or device to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

As for dependent claim 19:

Accordingly,

Re claim 19, the system of Jung et al. discloses the claimed invention except wherein the storage medium is a memory card. It would have been an obvious matter of design choice to have it programmed to use wherein the storage medium is a memory card, since such a modification would have involved the mere application of a known technique or a device to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509,

Art Unit: 2175

1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

As for dependent claim 20:

Accordingly,

Re claim 20, the system of Jung et al. discloses the claimed invention except wherein the memory card is a compact flash card. It would have been an obvious matter of design choice to have it programmed to use wherein the memory card is a compact flash card, since such a modification would have involved the mere application of a known technique or a device to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

As for dependent claim 22:

Accordingly,

Re claim 22, the system of Jung et al. discloses the claimed invention except wherein the font code is a bitmap font. Jung et al. teaches of using bitmap images in the conventional art (see paragraph 0005 for example). It would have been an obvious matter of design choice to have it programmed to use wherein the font code is a bitmap font, since such a modification would have involved the mere application of a

Art Unit: 2175

known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

As for dependent claim 23:

Accordingly,

Re claim 23, the system of Jung et al. discloses the claimed invention except wherein the inside code is a double-byte font set (DBCS). It would have been an obvious matter of design choice to have it programmed to use wherein the inside code is a double-byte font set (DBCS), since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

Response to Arguments

Art Unit: 2175

8. Applicants' arguments filed May 29th, 2008 have been fully considered but they are not persuasive. The Examiner refers applicants to MPEP 2123 that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

9. Applicant argues *Jung does not disclose that pre-recording at least one font file in the font recording space, the font file comprising a plurality of font codes. Moreover nowhere in the Jung does it disclose that character data can be employed for updating an on screen display. Namely, Jung does not disclose that updating an on screen display (OSD) based on the font code* (Applicant's Remarks, Pg.6). The Office respectfully disagrees.

10. It is noted that Jung discloses the above limitations in Para. 0022 and Figure 7. Jung teaches that the SP_DCSQT, a sub picture display control sequence table, contains display control information for outputting the PXD data, pixel data. Moreover the SP_DCCMD is control information on how the pixel data (PXD) and video pictures are combined and output, see Para. 0024). From the evidence set forth above Jung shows the following limitations: (1) *pre-recording at least one font file in the font recording space, the font file comprising a plurality of font codes* (2) *updating an on screen display (OSD) based on the font code*.

11. Applicant argues *Jung does not disclose that inputting an inside code to specify a font code in the font file* (Applicant's Remarks, Pg.6).

The Office respectfully disagrees.

12. It is noted that Jung discloses the above limitation in Para. 0123. In the following citation, Jung discloses that the stored subtitle data is loaded into the buffer of the reproducing apparatus before video data is reproduced, and with the reproduction of video data, the subtitle data is converted into graphic data by the rendered and made to overlap video images. Moreover Jung discloses in order to synchronize the subtitle data with video images decoded by the decoder by using the synchronization

Art Unit: 2175

information included in the text file, there is a channel through which events for sending or determining information on the reproducing time and the reproducing state of the decoder are exchanged with the decoder. From the evidence set forth above Jung shows the following limitations: *inputting an inside code to specify a font code in the font file*

13. Applicant argues *Jung fails to disclose editing a name of the multi-media data with inside code and the font file and Jung does not teach the feature of searching the font file for the font code mapping to the inside code* (Applicant's Remarks, Pg.7).

The Office respectfully disagrees.

14. It is noted that Jung in Paras 0049 and 0050 teaches the above limitation. Paragraph 0049 shows that the text data may be recorded in separate spaces for each of the languages. Additionally the text data may be converted into graphic data and the graphic data may be output. Thus Jung shows the above limitations.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Phantana-angkool whose telephone number is 571-272-2673. The examiner can normally be reached on M-F, 9:00-5:30 PM.

Art Unit: 2175

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DP
/David Phantana-angkool/
Examiner, Art Unit 2175

/Kieu D Vu/
Primary Examiner, Art Unit 2175